

## **REMARKS**

### **Status of the Claims**

The Applicants wish to inform the Examiner that the prior listing of claims submitted by the Applicants was in error. The Applicant inadvertently submitted new claims with the wrong numbers and claim identifiers. This is because the Applicants inadvertently failed to account for the previously withdrawn Claims 51-52.<sup>1</sup> To elaborate, Claims 51-52 were withdrawn after being restricted by the Examiner. The Applicants elected to prosecute Claims 30-50, but in the previously Listing of Claims, the Applicants inadvertently failed to list Claims 51-52 as withdrawn. Therefore, Applicants previous Listing of Claims, which provided new claims and numbered them 51-54, was improper because numbers 51 and 52 were not available.

Applicants have taken steps to correct the numbering of the claims, and respectfully submit that the above listing of claims is now proper and should replace all prior versions of Claims. That is, Claims 1-29 are listed as "withdrawn" and Claims 30-49 are listed as "not entered" because the Examiner did not enter the Applicants' amendment of January 18, 2005. The Examiner also did not enter Claim 50, however, it is listed as "currently amended" since the Applicant is presently amending it from its previous (and non entered) form. Claims 51 and 52 are listed as "withdrawn" since those claims are the unelected claims resulting from the Examiner's restriction requirement. For purposes of clarity, the Applicants also list the previously non entered Claims 53-54 as "not entered", because they were not entered. The applicants, however, do not wish to prosecute Claims 53-54, and wish the Examiner to cancel

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<sup>1</sup> The Examiner noted that Claims 51-52 were withdrawn in February 7, 2005 Advisory Action.

them by way of an Examiner's amendment upon entry. The Applicants now present new Claims 55-58, which correspond to the previously and erroneously numbered Claims 51-54.

### **Procedural Posture**

Following an interview with the Examiner on January 14, 2005, the Applicants filed an Amendment and Response on January 18, 2005. The Examiner did not enter the amendments, and issued an advisory action on February 7, 2005.

Among the items of discussion during the interview was the Applicants' strong contention that the U.S. Pat. No. 6,554,856 to Doorley et al. ("Doorley et al.") does not anticipate the claims of the invention or render the claims obvious. The Applicants pointed out that Doorley et al. lacks any teaching, motivation, or suggestion to securing an exterior stent to a lumen, the stent having a securing means on the interior layer of the stent (as was claimed in previously presented Claim 30). With respect to securing the stent to the lumen, the Applicants' representative informed the Examiner that Doorley et al. teaches the use of sutures, surgical thread, or a fastening ring that is placed on the exterior side of the stent. (See Doorley et al. reference numeral 3 in Figure 2) Doorley et al.'s method of securing their stent, the Applicants' representative pointed out, is very different from the Applicants' claimed step of securing the body lumen to the securing means, said securing means being on the interior layer of the external stent.

The Examiner appeared to recognize this distinction. However, the Examiner directed the Applicants' representative's attention to Figure 5, which is described in Column 3, Lines 24-28 of the Doorley et al. The Examiner posited that Figure 5 shows a securing means on the interior layer of the stent to which the lumen could be attached. The Applicants' representative countered that Figure 5 discloses an "internal stent" (see Col. 3, ln. 24), and that furthermore

there is simply no teaching of a securing means on the interior layer of the stent shown in Dooley, et al. in Figure 5. At best, Figure 5, and the corresponding description thereof, teaches affixing a helical shaped coil to a wire mesh stent. Indeed, it is unclear what function such a step serves, but the Applicants' representative explained that this neither anticipated nor rendered the claimed invention obvious.

Finally, the Examiner and Applicants' representative discussed amending the claims to further describe the step of securing the stent to the lumen. The Applicants' representative stated that support existed in the specification, page 8, for amending the claims to further clarify that the step of securing the stent to the lumen involved either (1) expanding the vessel into contact with the securing means on the interior layer of the stent, or (2) pushing or contacting the stent to the lumen by, for example, ratcheting the stent or compressing the stent to come into contact with the lumen.

Thus, the Interview Summary issued on January 14, 2005 should be clarified in two respects: first, the Applicants are amending the claims only to clarify the subject matter of the claims. The Applicant's firmly contend that Doorley et al. do not anticipate or render the claimed invention obvious. Second, while the Applicants agree that the Doorely et al. reference "does not disclose hooks or barbs on the interior layer of a stent" as the Examiner stated in the Interview Summary, the Applicants respectfully further submit that Doorely et al. do not disclose any type of securing means on the interior layer of the stent.

#### **Response to Objections and Rejections in November 30, 2004 Office Action**

The Applicants hereby respond to the objections and rejections raised in the Final Office Action of November 30, 2004 ("Office Action").

### **Claim Objections**

In the Final Office Action, the Examiner objected to Claim 46 for being substantially the same as Claim 37. In response, the Applicants have cancelled Claim 46.

### **Claim Rejections – 35 U.S.C. §102**

In the Final Office Action, the Examiner has rejected Claims 30-31, 37-39, and 41-42 under 35 U.S.C. §102(b) as allegedly being anticipated by Doorely et al. The Applicants respectfully traverse the rejection for reasons discussed below.

For a prior art reference to anticipate claims of a patent, it must expressly or inherently teach the entire claim. Moreover, a prior art reference must be enabling before it can anticipate. That is, it must provide a description sufficient to teach a person of ordinary skill in the art how to make and use the apparatus or process. Additionally, to qualify as an anticipatory reference, the reference must place the claimed invention in the possession of the public. Beckman Instruments, Inc. v. Productek AB, 892 F.2d 1547, 1550, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989).

As discussed above, Doorley et al. do not disclose the claimed elements of the invention. Most notably, Doorley et al. do not disclose the claimed step of placing a stent around the exterior of a body lumen and securing the lumen to the securing means on the interior side of the lumen. This limitation was in the previous version of the claims, and it is a limitation that the Applicants respectfully submit Doorely et al. do not disclose.

Moreover, Not Entered Claim 30 now clarifies that the step of securing the stent involves expanding said lumen into contact with said securing means, thereby securing the lumen to the securing means. New Claim 55 now clarifies that the step of securing involves contacting the interior layer of said stent to said lumen, thereby securing the lumen to the securing means. Both

amendments find support on page 4 of the specification. The Applicants respectfully submit that Doorley et al. do not disclose such steps.

Accordingly the rejections of Claims 30-31, 37-39, and 41-42 under 35 U.S.C. 102(b) is overcome, and allowance of said claims, along with new Claims 55-58 is respectfully requested.

### **Claims Rejections – 35 U.S.C. § 103**

Next, the Examiner has rejected Claims 32-36, 44-45 and 48 under 35 U.S.C. 103(a) as being allegedly unpatentable over Dooley et al.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Finally, and a very important factor here, the reference or combination of references must teach or disclose all of the claimed limitations of the invention. See id. The Applicants respectfully submit that the Examiner has not met these criteria.

The Examiner's rejections are predicated upon the Examiner's conclusion that Doorley et al. "discloses substantially all main [sic] structural limitations of the claimed invention..." of Claims 32-36 and 44-45. See Office Action, p.3. However, as discussed above, Doorley et al. do not teach or disclose the main limitations recited in independent non entered Claim 30 and new independent Claim 55. As discussed above, Doorley et al. do not disclose a is a method of

support comprising (1) providing a stent having a securing means on the interior layer of the stent; and (2) securing the lumen to the stent by either expanding the lumen into the securing means, or by contacting the stent to the lumen. Therefore, Doorley et al. do not disclose the structural limitations of independent Claims 30 and 55. Accordingly, any combination of the teachings of Doorley et al. with that which the Examiner presumes to be well known in the art cannot be the basis of a rejection under 35 U.S.C. § 103.

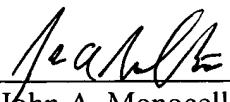
Since Independent Claims 30 and 55 overcome the rejection under 35 U.S.C. § 102 and 35 U.S.C. § 103(a), the Applicants respectfully submit that the remaining dependent Claims (30-31, 37-39, 44-52, and 56-58) are necessarily patentable.

Applicants respectfully submit that the patent application and the claims, as amended, therein are in a condition for allowance. Accordingly, reconsideration of all rejections is respectfully requested. Allowance of all claims at an early date is solicited.

Applicants would appreciate the courtesy of a telephone call should the Examiner have any questions or comments with respect to this response or the claim language for purposes of efficiently resolving same.

The Commissioner is hereby authorized to charge Deposit Account No. 03-2026 for any fees associated with this Request for Continued Examination.

Respectfully submitted,

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